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AUG 1 1 2004

OFFICE OF PETITIONS

In re Application of :
Friedman, Gray, Roti, Seaman, : DECISION REFUSING STATUS
Lopata, Cesare : UNDER 37 CFR 1.47(a)
Application No. 10/666,979 :
Filed: 17 September, 2003 :
Atty Docket No. 36287-04402 :

This is in response to the petition filed under 37 CFR 1.47(a) on 8 July, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 17 September, 2003, without an executed oath or declaration. Accordingly, on 12 December, 2003, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 8 July, 2004, petitioners filed a five (5) month extension of time, a declaration naming Allen R. Friedman, Stephen E. Gray, Stephen L. Roti, David A. Seaman, Benjamin B. Lopata, David, and Kelly Cesare as joint inventors, and signed by all joint inventors except Roti on Cesare on behalf of themselves and the non-signing joint inventors, the present petition, petition fee, and the late-filing surcharge.

Petitioners state that joint inventors Roti and Cesare have refused to sign the declaration. Petitioners further state that joint inventor Kelly Cesare has now changed her name to Kelly Cesare Coffey.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), petitioners have not provided proof that joint inventors Roti and Ceseare were ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ While the declarations of Catherine Y. Harper state that copies of the present application were sent to each non-signing inventor, it not clear whether the declarations were made with first-hand knowledge on the part of Ms. Harper.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

¹MPEP 409.03(d).

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

With regards to item (2) the declaration is defective in that it does not state the residence, mailing address, or citizenship of non-signing inventor Cesare.² A statement of the inventor's citizenship is a statutory requirement and cannot be waived.³ A new oath or declaration, containing the residence, mailing address, and citizenship of both inventors, signed by the signing inventor on behalf of himself and the non-signing inventor in compliance with 37 CFR 1.63 and 1.67 is required.

Furthermore, the declaration does not identify the date that the application was filed. Any oath or declaration filed with a renewed petition must identify both the application number and filing date of the application.

Additionally, with regard to non-signing inventor Cesare's purported change of name, the inventorship is determined by the executed oath or declaration, a petition under 37 CFR 1.182 to correct an inventor's name, accompanied by the requisite petition fee, must be filed if an inventor's name is not correctly spelled on the declaration. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 must be submitted with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

²MPEP 605.01.

³35 U.S.C. § 115, MPEP 605.01.

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries related to this decision should be directed
to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions